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Serial No. 10/713,739 Confirm. No.: 2701
Art Unit: 2142 Examiner: Christopher D Biagini
Docket: AUS920030777US1(4016)

REMARKS

Claims 1, 3-4, 8-10, 12-13, 15-18, 20, and 23 are pending. Claims 10, 12-13, 15-18, 20, and 23 stand rejected under 35 USC § 101 and claims 1, 3-4, 9-10, 12, 15, 17-18, and 20 stand rejected under 35 USC § 103. Applicant respectfully traverses the rejections in light of the amendments and the following remarks.

Applicant requests interview

Applicant respectfully requests an interview if it would expedite disposition of the application. The undersigned attorney would welcome and encourage a telephone conference with Examiner at (512) 243-5936.

Amendments to the claims

Support for amendments to claims 1, 10, 18, 20, and 23 can be found in, e.g., paragraphs 15, 28, 35, 50, and 51, as well as the Abstract.

New claims

Support for new claims 33, 34, and 35 can be found in, e.g., paragraph 35. Note that paragraph 35, for instance, describes grouping recipients and an order of generation of emails based upon the groups.

Claim rejections under 35 USC § 101

Claims 10, 12-13, 15-18, 20, and 23 stand rejected under 35 USC § 101 as being non-statutory subject matter. In particular, claims 10, 12-13, and 15-17 are rejected for covering embodiments that may consist entirely of software. The rejection cites MPEP 2106.1. Applicant argues that the amendment of claim 10 overcomes this rejection and, thus requests that the rejection be withdrawn.

With respect to claims 18, 20, and 23, Applicant respectfully submits that upon entry of the above amendments, these claims clearly describe statutory subject matter. Applicant traverses the rejections and requests the rejections be withdrawn.

Claim rejections under 35 USC § 103(a)

The Office action rejected claims 1, 3-4, 9-10, 12, 15, 17-18, and 20 under 35 USC § 103(a) as being unpatentable over Beyda, U.S. Patent No. 6,636,965 (hereinafter referred to as "Beyda") in view of Gilbert, U.S. Patent No. 6,529,942 (hereinafter referred to as "Gilbert").

To establish a prima facie case of obviousness, the modification or combination must teach or suggest all of Applicants' claim limitations.[1]

The combination of Beyda and Gilbert fails to establish a prima facie case of obviousness for independent claims 1, 10, and 18 because the combination fails to teach or suggest all of Applicants' claim limitations. In particular, the combination fails to teach or suggest identifying groups of recipients to receive the same or substantially similar email messages and generating the email comprising the email message with the instance and the one or more additional emails in an order of generation based upon the groups of recipients.

Beyda describes a messaging processing system that allows a user to create messages for delivery to a number of recipients and to include encrypted comments to be available to less than all of the recipients.[2] However, Beyda describes analyzing each recipient of the message in order of the address list.[3] In particular, Beyda states that

> ...at step 70, the message processor analyzes the first recipient on the address list..., at step 80, the message processor determines if all recipients on the address list ...have been analyzed.... If not, the next recipient on the address list is obtained at step 84 and processing returns to step 72....[4]

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[1] *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).
[2] Beyda at Abstract.
[3] Beyda at col. 3, lines 44-65 and Fig. 3, especially blocks 70, 80, and 84.
[4] Beyda at col. 3, lines 44-65; see also Fig. 3, especially blocks 70, 80, and 84.

Gilbert describes an email system that allows a user to customize text for a specific recipient in a multiple recipient mail system by recognizing embedded processing codes.[5] However, Gilbert does not describe grouping the recipients by the email server to receive the same or substantially similar email messages or an order in which to process recipients to generate emails.[6]

Claims 1 and 18 comprise "identifying, by an email server, groups of recipients to receive the same or substantially similar email messages." In Beyda, the grouping is determined by the user on a client machine that creates lists of the recipients with the common message and the comments.[7] In Gilbert, the grouping is established by the user on the client machine by associating codes with recipients that correspond to codes embedded in the text of the message.[8]. Thus, the combination of Beyda and Gilbert fails to teach or suggest "identifying, by an email server, groups of recipients to receive the same or substantially similar email messages." Similarly, claim 10 comprises "a recipient selector to identify groups of recipients to receive the same or substantially similar email messages" and the combination of Beyda and Gilbert fails to teach or suggest "a recipient selector to identify groups of recipients to receive the same or substantially similar email messages...." Applicant respectfully traverses the rejections and requests that the claims 1, 10, and 18 be allowed.

Claims 1 and 18 comprise "generating the email comprising the email message with the instance and the one or more additional emails in an order of generation based upon the groups of recipients." In Beyda, the order is based upon the order of the recipients on the address list.[9] In Gilbert, the ordering is not discussed.[10] Thus, the combination of Beyda and Gilbert fails to teach or suggest "generating the email comprising the email message with the instance and the one or more additional emails in an order..." and fails to teach or suggest "an order based upon the groups of recipients...." Similarly, claim 10 comprises "the email generator to generate emails in an

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[5] Gilbert at Abstract.
[6] See Gilbert at Figs. 4A and 4B as well as the corresponding text at col. 7, lines 7-65.
[7] See Beyda at Fig. 2 and col. 3, lines 7-32.
[8] Gilbert at Figs. 2-3, col.4, lines 54-67, and col. 5, lines 1-10.
[9] Beyda at col. 3, lines 44-65; see also Fig. 3, especially blocks 70, 80, and 845.
[10] Gilbert at Figs. 2-3, col.4, lines 54-67, and col. 5, lines 1-10.

order of generation based upon the groups...." Thus, the combination fails to teach or suggest "the email generator to generate emails in an order of generation..." as well as "an order of generation based upon the groups...." Applicant respectfully traverses the rejections and requests that the claims 1, 10, and 18 be allowed.

Furthermore, the new dependent claims 33, 34, and 35 include limitations that describe a particular grouping and order. In particular, the limitations describe an email server for

> generating the email comprising the email message with the instance and the one or more additional emails in the order, wherein the order comprises composing a general message for all recipients, thereafter composing a detailed message for a group of the recipients, and thereafter composing specific messages for individual recipients that are part of the group of the recipients....

The combination of Beyda and Gilbert fails to describe a grouping and determining an order of generation and, thus, inherently fails to describe the more specific grouping and order as described in claims 33, 34, and 35. Applicant respectfully traverses the rejections with respect to these new claims and requests that the claims 33, 34, and 35 be allowed.

Generally, the claims dependent upon claims 1, 10, and 18 include the limitations of their respective independent claims. So the rejections of the dependent claims are traversed by the arguments above. Applicant respectfully requests that the rejections of the dependent claims be withdrawn and the claims be allowed.

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CONCLUSION

Applicant respectfully addresses the objections and traverses the claim rejections under 35 USC §§ 101 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the Office action. In light of the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Thus, Applicant requests that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

October 9, 2008   /Jeffrey S Schubert/
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Date

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